

REMARKS

The Office Action of February 28, 2008 (hereinafter "Office Action"), rejected Claims 1-5, 7-17, 19-29, 31-41, and 43-49 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,957,366, issued to McDonald (hereinafter "McDonald"). Claims 6, 18, 30, and 42 were rejected under 35 U.S.C. § 103(a) as being obvious in view of McDonald.

With this response, Claims 1-49 remain pending.

Applicants respectfully request reconsideration and allowance of the pending claims. Prior to presenting the reasons why applicants believe that the pending claims are in condition for allowance, brief summaries of the claimed subject matter and cited reference, McDonald, are presented. However, it should be appreciated that the summaries are set forth to assist the Examiner in recognizing the differences between the claimed subject matter and McDonald, and should not be construed as limiting upon the claimed subject matter.

Summary of Claimed Subject Matter

The present invention is directed at determining whether a software application is validly installed on a target computer. In order to do so, a validation manifest is used. The validation manifest includes computer-executable validation actions the results of which, when carried out, can be used to determine whether the software application is validly installed on the target computer.

The computer-executable validation actions can comprise any number of different actions, each of which can be specifically tailored to its associated software application. Indeed, the validation actions include activities such as executing a program or library module associated with the software application and/or comparing various aspects of the software application and target computer environment, each of which provides results that can be used to determine whether the software application is installed validly and correctly. The validation actions may

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also include information for installing the software application validly onto the target computer, i.e., correcting issues regarding an improper installation.

Differentiating External Installation Issues from Internal Operational/Logic Issues

Applicants note that validating whether a software application is installed correctly is substantially distinct from determining whether the software application is faulty/buggy in operation. Validating whether a software application is installed correctly corresponds to external aspects of the software application and how it (the software application) relates to its environment. In contrast, software testing (i.e., for operational flaws or "bugs" in the execution of the software) is directed to internal aspects of the software application, focusing on whether the application operates as intended. Unfortunately, many may confuse the issues (improper installation vs. functional/operational issues) as the net result is often that a software application fails to execute as desired. However, one of ordinary skill in the art readily appreciates the differences between installation issues and operational/logic issues.

The following scenarios may be useful in appreciating the distinction between external installation issues and internal operational issues.

- When a software application fails to execute, is it because (a) the application has "bugs" that cause it to abort, or (b) the application is not installed correctly on the target computer. Without being able to determine first whether the software application is installed correctly, one cannot say. Clearly, one must be able to validate an installation independent of testing the operational logic of the software application.
- If, during execution of a software application, the application aborts its execution, is it because (a) the program executed an invalid instruction due to flawed logic that caused it to abort, or (b) a library module was not properly installed such that when a routine within the library is called the program failed to locate the library and aborted. As above, without being

able to determine first whether the software application is installed correctly, one cannot say whether the application aborted due to a faulty installation or faulty logic.

- When a customer calls customer support to obtain assistance in getting an application to run on a computer, the first thing that the customer support personnel validates is whether the software application is properly installed. Currently, a support person validates an installation by having the customer manually check various aspects relating to the software application, which manual checks indicate whether the application is properly installed or not. They do this because they understand that if the application is not properly installed, they cannot determine if the operational logic is faulty.

Clearly, installation validation is substantially and patentably distinct from testing the internal operations of a software application for bugs.

Brief Description of McDonald (U.S. Patent No. 6,957,366)

McDonald presents a Web-based system for tracking software bugs. In the McDonald system, a software vendor provides a client with a list of functions (relating to the software application) to be tested. See Col. 3, lines 43-44. Based on this list, the client tests the assigned functions of the software. See Col. 4, lines 52-53. This results of the client's tests are then entered into a particular program/form set up for clients to enter bugs relating to that function. *Id.* The results are entered as "pass," "fail," and "fail again." See Col. 4, lines 55-60.

While McDonald may present a fine system for tracking/recording whether one or more functions of a software application operate as intended (i.e., are bug-free), McDonald fails to disclose a validation manifest comprising computer-executable validation actions, and further fails to disclose validating whether the software application is properly installed on the client's computer.

35 U.S.C. § 102(e) Rejections

Claim 1

Claim 1 was rejected as being anticipated by McDonald. For the following reasons, applicants respectfully traverse the rejection.

Claim 1 reads as follows:

1. A computer-implemented method for determining whether a software application is properly installed on target computer, comprising:
obtaining a validation manifest from the software provider of the software application for validating the installation of the software application, ***the validation manifest comprising computer-executable validation actions for determining whether the software application is properly installed on the target computer;***
executing the validation actions in the validation manifest; and
based on the results of the executed validation actions, determining whether the software application is properly installed on the target computer. (Emphasis added.)

Applicants submit that McDonald fails to disclose a "*validation manifest comprising computer-executable validation actions for determining whether the software application is properly installed on the target computer.*" Indeed, while the Office Action cites to McDonald, Col. 3, lines 43-49, this cited passage is directed to functional testing of the software, not validating the installation of the software application. Further still, this passage fails to disclose "***computer-executable*** validation actions." Rather McDonald discloses a list that identifies functions that the client/tester manually carries out.

Applicants further submit that McDonald fails to disclose "executing the validation actions in the validation manifest," as recited in Claim 1, especially in the context of the claim as a whole. Indeed, the claim recites a "computer-implemented method" and that the validation actions are "computer-executable validation actions." In contrast, McDonald discloses that a

software vendor provides a list that identifies functions that the client/tester is to test. Nothing in McDonald discloses that these identified functions are computer-executable instructions.

The Office Action curiously cites to McDonald, Col. 6, lines 5-6, that states: "when a new release is installed, there are new functionalities of the software to be tested." While it is known that new software must be functionally tested, such testing (especially as described by McDonald) is focused on the internal operation of the software, i.e., the logic that carries out the desired functionality. Clearly, this passage assumed proper installation and cannot be reasonably construed as being equivalent to executing computer-executable validation instructions to determine whether the software application is properly installed on a target computer.

Similarly, while citing to McDonald, Col. 1, lines 26-30, this passage simply states that an application (a development application) will be loaded onto the client system. Obviously, while "loading" and "installing" are likely equivalent in this context, nothing in McDonald suggests validating the application after it has been loaded onto a computer. McDonald is, rather, directed to the functionality of the loaded software application (i.e., the operation of the software).

In view of the above, applicants submit that McDonald fails to disclose each and every element of Claim 1. Accordingly, a proper prima facie case of anticipation cannot be made. Therefore, applicants request that the 35 U.S.C. § 102(e) rejection of Claim 1 be withdrawn and the claim allowed.

Claims 2-5 and 7-12

Claims 2-5 and 7-12 depend from independent Claim 1. As Claim 1 is in condition for allowance, applicants submit that Claims 2-5 and 7-12 are also in condition for allowance. Indeed, it is well established that if an independent claim is allowable, then any claim depending

therefrom is also in condition for allowance. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

In addition to depending from independent Claim 1, applicants submit that Claims 2-5 and 7-12 recite additional subject matter that further distinguishes the claims from McDonald, some of which are recited below.

Claim 5

Claim 5 recites the following:

5. The method of Claim 4, wherein the aspect of the software application compared by the comparison instruction is ***the modification date of a file provided as part of the software application***. (Emphasis added.)

McDonald discloses a database for tracking/logging problems associated with a software application, and that database includes a date that a function was tested as well as a date that the function was fixed. However, irrespective of whether or not McDonald recites a database that stores dates, applicants submit that a database of data cannot be reasonably construed as executing a comparison of a modification date to determine whether a software application is properly installed on a computer.

For the additional reasons set forth, applicants submit that McDonald fails to disclose each element of Claim 5. Accordingly, McDonald fails to anticipate this claim and applicants request that the 35 U.S.C. § 102(e) rejection be withdrawn and the claim allowed.

Claim 9

Claim 9 recites the following:

9. The method of Claim 4, wherein the aspect of the software application compared by the comparison instruction is ***a system registry value of the computer system upon which the software application is***

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installed and stored on the associated with the software application.
(Emphasis added.)

The Office Action refers to the discussion of Claim 5, particularly that McDonald discloses a database for tracking/logging problems associated with a software application. Moreover, the Office Action asserts that a test identifier and a tracking number are viewed as system registry values. Applicants submit that this assertion is unsupportable, and that one of ordinary skill in the art would have readily recognized the distinction between a system registry value and fields in a database stored by the software vendor - as the system registry values correspond to the user's computer and identify particular critical values for the computer system.

Irrespective of whether or not McDonald recites system registry values, applicants further submit that McDonald fails to disclose executing a computer-executable instruction that compares a registry value on the computer system to determine whether a corresponding software application is properly installed on a computer.

For the additional reasons set forth, applicants submit that McDonald fails to disclose each element of Claim 9. Accordingly, McDonald fails to anticipate this claim and applicants request that the 35 U.S.C. § 102(e) rejection be withdrawn and the claim allowed.

Claim 12

Claim 12 recites the following:

12. The method of Claim 1, wherein the validation manifest further comprises a *computer-executable corrective action for correcting an improperly installed software application*, and wherein the method further comprises, upon detecting a negative result from *executing a validation action, executing a corrective action associated with the validation action*. (Emphasis added.)

The Office Action apparently asserts that a value in a database stored by the vendor that indicates a date that a bug was fixed can be reasonably construed as a "*computer-executable*

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corrective action," as recited in Claim 12. Applicants submit that this assertion is unsupportable. Applicants submit that one skilled in the art would readily recognize the distinction between a fix date value in a database and a computer-executable instruction to correct an installation issue. The fact that some corrective action has taken place to fix a bug in software cannot be reasonably construed as a computer-executable corrective action in a validation manifest.

Applicants assert that the database and the fix date is NOT included as part of the validation as manifest (as previously identified by the Office Action as the list of functions to test). The fix date is not part of the list of functions provided to the tester.

Applicants further assert that nothing in McDonald discloses a corrective action in a validation manifest that is executed "upon detecting a negative result from executing a validation action."

For the additional reasons set forth, applicants submit that McDonald fails to disclose each element of Claim 12. Accordingly, McDonald fails to anticipate this claim and applicants request that the 35 U.S.C. § 102(e) rejection be withdrawn and the claim allowed.

Claim 13

Independent Claim 13 recites subject matter similar to those elements of Claim 1 discussed above, and was rejected under similar rationale as was Claim 1. In particular, Claim 13 recites, *inter alia*:

obtains a validation manifest associated with the software application from the provider of the software application, ***the validation manifest comprising a plurality of computer-executable validation actions*** for determining whether the software application is properly installed on the target computer. (Emphasis added.)

As discussed above, McDonald fails to disclose a "***validation manifest comprising a plurality of computer-executable validation actions***." Rather, McDonald discloses obtaining a

list of functions that a user is to test. Nothing in McDonald suggests that these are computer-executable instructions, but simply features of a software application that the tester is to manually test and report on.

For these reasons, applicants submit that McDonald fails to disclose each and every element of independent Claim 13. Accordingly, applicants request that the 35 U.S.C. § 102(e) rejection be withdrawn and the claim allowed.

Claims 14-17 and 19-24

Claims 14-17 and 19-24 depend from independent Claim 13. As Claim 13 is in condition for allowance, applicants submit that Claims 14-17 and 19-24 are also in condition for allowance. Accordingly, applicants request that the 35 U.S.C. § 102(e) rejections be withdrawn and the claims allowed.

Claim 25

While differing in scope, Claim 25 recites similar subject matter to that discussed above in regard to Claim 1. In particular, Claim 25 recites, *inter alia*:

obtain a validation manifest from the provider of the software application, the validation manifest comprising validation actions for determining whether the software application is properly installed on the client computer, ***each validation action comprising a computer-executable action*** for determining at least one aspect of whether the software application is properly installed on the client computer, data for use in the computer-executable action, and a result value indicative of whether at least the one aspect of the software application is properly installed on the client computer. (Emphasis added.)

While McDonald may disclose providing a list of functions to be tested to a tester, applicants submit that a list of functions to be tested (even manually tested) cannot be construed as validation actions comprising computer-executable actions. Indeed, the list may identify the

function to be tested by the tester but does not describe computer-executable instructions that test aspects of a software installation.

For these reasons, applicants submit that McDonald fails to disclose each and every element of independent Claim 25. Accordingly, applicants request that the 35 U.S.C. § 102(e) rejection be withdrawn and the claim allowed.

Claims 26-29 and 31-36

Claims 26-29 and 31-36 depend from independent Claim 25. As Claim 25 is in condition for allowance, applicants submit that Claims 26-29 and 31-36 are also in condition for allowance. Accordingly, applicants request that the 35 U.S.C. § 102(e) rejections be withdrawn and the claims allowed.

Claim 37

While differing in scope, Claim 37 recites similar subject matter to that discussed above in regard to Claim 1. In particular, Claim 37 recites, *inter alia*:

obtaining a validation manifest associated with the software application from the software application provider, the ***validation manifest comprising computer-executable validation actions for determining whether the software application is properly installed on the target computer.*** (Emphasis added.)

While McDonald may disclose providing a list of functions to be tested to a tester, applicants submit that a list of functions to be tested (even manually tested) cannot be construed as "computer-executable validation actions for determining whether the software application is properly installed on the target computer." Indeed, the list may identify the function to be tested by the tester but does not describe computer-executable instructions that test the validity of a software application installation.

For these reasons, applicants submit that McDonald fails to disclose each and every element of independent Claim 37. Accordingly, applicants request that the 35 U.S.C. § 102(e) rejection be withdrawn and the claim allowed.

Claims 38-41 and 43-48

Claims 38-41 and 43-48 depend from independent Claim 37. As Claim 37 is in condition for allowance, applicants submit that Claims 38-41 and 43-48 are also in condition for allowance. Accordingly, applicants request that the 35 U.S.C. § 102(e) rejections be withdrawn and the claims allowed.

Claim 49

While differing in scope from other independent claims, Claim 49 recites similar subject matter to that discussed above in regard to Claim 1. However, in contrast to Claim 1, Claim 49 recites subject matter that is not found in other independent claims. In particular, Claim 49 recites, *inter alia*:

obtaining a validation manifest associated with the software application from the provider of the software application, the validation manifest comprising validation actions for determining whether the software application is properly installed on the target computer, ***wherein each validation action in the validation manifest comprises a token corresponding to a computer-executable action, data for use by the computer-executable action in validating the software application, and an expected result of the computer-executable action indicative of a valid installation.*** (Emphasis added.)

While McDonald may disclose providing a list of functions to be tested to a tester, applicants submit that a list of functions to be tested (even manually tested) cannot be construed as validation actions comprising computer-executable actions. Indeed, the list may identify the

function to be tested by the tester but does not describe computer-executable instructions that test aspects of a software installation.

Applicants also note that McDonald fails to disclose that the list of functions to be tested includes "*data for . . . validating the software application*," as recited in Claim 49. Simply put, the McDonald list identifies functions to be tested, not computer-executable actions and data to support those actions. Further still, McDonald fails to disclose an "*expected result of the computer-executable action indicative of a valid installation*," as recited in Claim 49. Indeed, the McDonald list simply identifies a function to be tested, nothing more and certainly not an expected result indicative of a valid installation.

For these reasons, applicants submit that McDonald fails to disclose each and every element of independent Claim 49. Accordingly, applicants request that the 35 U.S.C. § 102(e) rejection be withdrawn and the claim allowed.

35 U.S.C. § 103(a) Rejections Over McDonald

Claims 6, 18, 30, and 42 were rejected as being obvious in view of McDonald. Each substantially recites, *inter alia*, "the aspect of the software application compared by the comparison instruction is the file size of a file provided as part of software application."

Irrespective of whether comparing a file size was well-known, nothing in McDonald discloses or otherwise suggests a validation manifest of computer-executable validation actions that include a validation action to test "file size of a file provided as part of software application."

Applicants further note that Claims 6, 18, 30, and 42 depend from independent claims that are in condition for allowance. Accordingly, applicants submit that irrespective of knowledge that may have been known by those skilled in the art, Claims 6, 18, 30, and 42 are in condition for allowance by virtue of depending from allowable independent claims.

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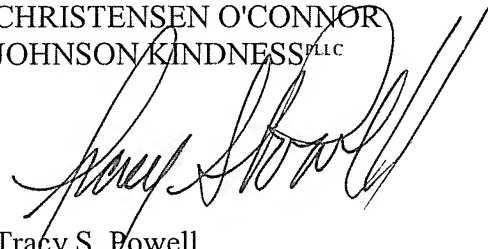
Applicants respectfully request that the 35 U.S.C. § 103(a) rejections of Claims 6, 18, 30, and 42 be withdrawn and the claims allowed.

CONCLUSION

In view of the foregoing, applicants submit that Claims 1-49 are in condition for allowance. Reconsideration and allowance of the pending claims at an early date is requested. If the Examiner has any questions regarding this matter, the Examiner is invited to contact applicants' representative at the number below.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Tracy S. Powell", is written over the printed name of the law firm.

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